

REMARKS

Prior to entry of this Amendment, Claims 49-54 were pending and under consideration. With this Amendment, Claims 49 and 52 are being amended and no claims are being added or canceled. Thus, after entry of this Amendment, Claims 49-54 are pending and under consideration.

The Amendments of the Specification

The specification has been amended to correct the wording of the priority claims. Basis for this amendment is found at page 1 lines 21-27 and page 2 lines 16-21 of the Patent Application Transmittal filed November 20, 2001, and in the specification at page 1 lines 3-6. No new matter is introduced by this amendment. (A clean copy of this amendment is enclosed herein, for the benefit of the Examiner, as Attachment A.)

The Amendments of the Claims

Claim 49 has been amended to correct a clerical error in the alphabetical identification of the steps in the claim. In Claim 49, a hyphen has been inserted between the words "single" and "stranded." Claims 49 and 52 have been amended to clarify the description of the targeting polynucleotides. Basis for this amendment is found, for example, in the claims as originally filed and at page 27 lines 16-25. No new matter is introduced by this amendment. (A clean copy of the claim is enclosed herein, for the benefit of the Examiner, as Attachment B).

Rejection of Claims 49-54 Under 35 U.S.C. §102(b)

Claims 49-54 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 4,888,274 to Radding *et al.* (Radding *et al.*). The rejection is traversed.

To anticipate a claim under 35 U.S.C. § 102(b), a reference must teach every element of the rejected claim (MPEP § 2131).

Independent Claim 49 recites a composition comprising a plasmid, at least two single-stranded targeting polynucleotides and at least one recombinase. Independent Claim 52 recites a method of contacting a plasmid with a recombinase and at least two single-stranded targeting polynucleotides. Both Claims 49 and 52 recite that the single-stranded targeting polynucleotides are "substantially complementary to each other."

Radding *et al.* teach a method that comprises combining a target nucleic acid encoding a polypeptide of interest with a recombinase and a single-stranded targeting polynucleotide. The Patent Office cites various passages in Radding *et al.* in the rejection. However, the teachings in these passages all refer to one probe, or a plurality of the *same* probe. None of these passages teaches two single-stranded targeting probes that are substantially complementary to each other.

For example, the Patent Office indicates that the invention of the instant claims is shown in FIG. 1. However, FIG. 1 clearly shows a *single* probe bound to a double-stranded target. FIG.s 2, 7, and 8 also show a *single* probe. In another example, the Patent Office refers to column 5, lines 49-52. However, this passage teaches that the probes are denatured and *isolated* in single-strand form for use in the RecA reaction. Again, Radding *et al.* are describing the preparation and use of a *single* probe. In another example, the Patent Office refers to column 6 lines 5-38. However, this passage describes *single* biotin labeled probes, such as those derived from Bio-11-dUTP and from Bio-19-SS-dUTP. Nowhere do Radding *et al.* teach or suggest at least two single-stranded probes that are "substantially complementary to each other" and hence Radding *et al.* do not anticipate the claimed subject matter.

Accordingly, since the cited reference fails to teach each and every limitation of the pending rejected Claims, Applicants request that the rejection of Claims 49-54 under 35 U.S.C. § 102(b) be withdrawn.

Conclusion

Applicants submit that the Claims 49-54 satisfy all of the statutory requirements for patentability and are in condition for allowance and early notification of the same is kindly solicited.

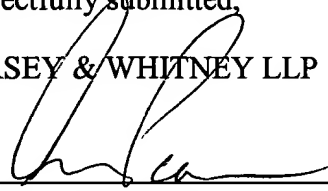
No fees beyond those being submitted concurrently herewith are believed due in connection with this Amendment. However, the Commissioner is authorized to charge any additional required fees, or credit any overpayment, to Dorsey & Whitney LLP Deposit Account No. 50-2319 (Our Order No. A-64580-5/AMP/JFB).

Dated: 3/16/04

Four Embarcadero Center, Suite 3400
San Francisco, CA 94111-4187
Telephone (650) 494-8700
Facsimile (650) 494-8771

Respectfully submitted,

DORSEY & WHITNEY LLP


Ann M. Caviani Pease
Reg. No. 42,067

ATTACHMENT A

This application is a continuation-in-part of U.S. application Serial No. 09/927,160 filed August 9, 2001, which is a continuation of U.S. application Serial No. 09/079,877 filed May 15, 1998, which is, in turn, a continuation-in-part of U.S. application Serial No. 08/910,415 filed August 13, 1997. This application is a continuation of U.S. application Serial No. 08/910,415, filed August 13, 1997, now abandoned, which claims priority from U.S. application Serial No. 60/041,173, filed March 21, 1997, and which is a continuation-in-part of U.S. application Serial No. 08/275,916, filed July 14, 1994, now U.S. Pat. No. 5,763,240. U.S. application Serial No. 08/910,415 is a continuation-in-part of U.S. application Serial No. 08/385,713, filed February 8, 1995, now U. S. Pat. No. 6,255,113, which is a continuation of U.S. application Serial No. 07/939,767, filed September 2, 1992, now abandoned, which is a continuation-in-part of U.S. application Serial No. 07/873,438, filed April 24, 1992, now abandoned.

ATTACHMENT B

Claims 1-49 (canceled).

Claim 49 (currently amended): A composition comprising:

- a) a plasmid comprising a target nucleic acid sequence;
- b) at least two single-stranded targeting polynucleotides comprising a first and a second single-stranded targeting polynucleotide which are substantially complementary to each other, and wherein each of said targeting polynucleotides comprises a homology clamp that substantially corresponds to or is substantially complementary to said target nucleic acid sequence; and
- c) at least one recombinase.

Claim 50 (previously presented): The composition of claim 49 wherein said targeting polynucleotides are bound to said plasmid.

Claim 51 (previously presented): The composition of claim 49 wherein at least one of said targeting polynucleotides is biotinylated.

Claim 52 (currently amended): A method comprising contacting a plasmid comprising a target nucleic acid with a recombinase and at least two single-stranded targeting polynucleotides which are substantially complementary to each other, and wherein each of said targeting polynucleotides comprises a homology clamp that substantially corresponds to or is substantially complementary to said plasmid target nucleic acid.

Claim 53 (previously presented): The method of claim 52 wherein said targeting polynucleotides are bound to said plasmid.

Claim 54 (previously presented): The method of claim 52 wherein at least one of said targeting polynucleotides is biotinylated.